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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/665,899

09/18/2003

Brian T. Worsham

25343/37:7

7026

32642

7590

09/14/2009

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EXAMINER

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ART UNIT

PAPER NUMBER

3689

MAIL DATE

DELIVERY MODE

09/14/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/665,899	Applicant(s) WORSHAM ET AL.	
	Examiner THUY-VI NGUYEN	Art Unit 3689	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 July 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-35 and 37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-35 and 37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 September 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after allowance or after an Office action under *Ex Parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 07/29/09 has been entered.

Claims Status

2. This is in response to the applicant's communication filed on 07/29/2009 wherein:

Claims 19-35, 37 are currently pending;

Claims 19, 23, 25, 29, 32-33 and 37 have been amended;

Claims 1-18 and 36 have been cancelled;

As of 07/29/09, independent method claim 19 is amended as followed:

19. A computer-implemented method of returning customized information from a computer-readable storage medium in response to requests about a specific tangible object having attributes, the method comprising:

receiving at a computer a first request from a first venue for information on the specific tangible object in inventory;

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reading a representation of the tangible object from the computer-readable storage medium, the representation including attributes of the specific tangible object;

generating a first view of the specific tangible object, wherein the first view is generated by applying a first rule associated with the first venue to the representation of the specific tangible object such that the first view includes only attributes in compliance with the first rule;

returning the first view to the first venue;

receiving at the computer a second request from a second venue for information on the specific tangible object;

generating a second view of the same specific tangible object, wherein the second view is generated by applying a second rule associated with the second venue to the same representation of the same specific tangible object read from the same computer readable storage medium such that the second view includes only attributes in compliance with the second rule, and wherein the second view differs from the first view in that at least one attribute included in the second view is not included in the first view; and

returning the second view to the second venue.

Drawings

3. The drawings are objected to because the drawing needs to be more clear in identifying every element from the disclosure. For example: rules, attributes, databases, data field need to be identified. Corrected drawing sheets in compliance

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with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 19 and 23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to

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one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicant has added the features in the limitations to the claims related to *“generating a second view of the same specific tangible object, wherein the second view is generated by applying a second rule associated with the second venue to the same representation of the same specific tangible object read from the same computer readable storage medium such that the second view includes only attributes in compliance with the second rule, and wherein the second view differs from the first view in that at least one attribute included in the second view is not included in the first view”*. Examiner has reviewed applicant’s disclosure and submits that this added limitation finds no support in the specification as currently written and is, therefore, directed to new matter.

Applicant’s specification appears to teach the multiple “database 20”, *this database may be a single database or a composite made up of several databases* {figure 2, pars. 0026-0034}, and “multiple databases 60” *that may be a common database into which each of them inputs information, or that may be a compilation of separate databases that each dealer maintains. As long as these databases are accessible, and preferably use the same configuration of information* (pars. 0035-0037). The specification discloses “a single database” or “a composite made up of several databases” which may be inherently discloses “a storage medium” in a database. However, the specification doesn't disclose the structure of where the information is stored i.e. computer storage medium” or memory of hardware, and all the object

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information are read or generated from the same computer readable storage medium.

Therefore the Examiner submits that these teachings do not provide adequate support for the claim language of claims 19, 23, 32 as currently amended. Applicant's specification provides no teaching or disclosure of features "the same representation of the same specific tangible object read from the same computer readable storage medium" as stated above.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 19-24 (method), 25-31 (method), and 32-35 and 37 (method) are rejected under 35 U.S.C. 102(e) as anticipated by SKORSKI (US 2004/0012631) or, in the alternative, under 35 U.S.C. 103(a) as obvious over BAMFORD (US 7,496,543).

As for independent claim 19, SKORSKI discloses a computer-implemented method of returning customized information from a computer-readable storage medium in response to requests about a specific tangible object having attributes, the method comprising:

a) receiving at a computer a first request from a first venue (website) for information on the specific tangible object in inventory;

{see figure 1-3, at least pars 0019, 0026-0029 wherein SKORSKI inherently discloses the receiving a request for a specific tangible object, e.g. consumer *selects a link requesting* the online catalog for purchasing a product/object, the consumer *generates an input request* for a particular product, and information about the product will be retrieved, e.g. a user request may be is a retailer or a patient}

b) reading a representation of the tangible object from the computer-readable storage medium, the representation including attributes of the specific tangible object;

{see figures 1-2 at least pars. 0019-0024, pars. 0028-0029 wherein SKORSKI discloses the database storage computer system comprising a single database, which store product information/object information for a *particular product such as product name, product SKU numbers, price*}

c) generating a first view of the specific tangible object, wherein the first view is generated by applying a first rule associated with the first venue to the representation of the specific tangible object such that the first view includes only attributes in compliance with the first rule;

{see figures 1-2, at least pars. 0009-0010 wherein SKORSKI discloses different type of user access to see/view different type/attribute of specific product depend of the user's level access into the database system. For example: *"display data (product information) according to selected criteria, and in different formats, according to the type of user that accesses information. In such manner, different populations of users can access different catalogs built from the same data"*.

see pars. 0013, 0024-0029, wherein SKORSKI inherently discloses generating a first view of the object applying a first rule, and the first view includes only attributes in compliance with the first rule. For example, SKORSKI discloses the steps of *filtering* of a product database to derive an online catalog for a retailer, e.g. *select product by product group identification* and then by *specific products*. Each subset of product group identification generates different price/attributes for the same specific product as shown on figure 2. For an example if the patient accesses the online medical store to view product information, the information is filter and only shows the price of specific product as patient level group identification. *The price information of other group (e.g. retailer physicians practice group) will be filtered or the retailer physician's practice will see the same item/product at different price*}.

d) returning the first view to the first venue;

{see figures 1-3, pars. 0024-0029, wherein SKORSKI discloses *The price information of other group (e.g. retailer physicians practice group) will be filtered or the retailer physician's practice will see the same item/product at different price*}

e) receiving at the computer a second request from a second venue for information on the specific tangible object;

{see figure 1-3, at least pars 0019, 0026-0029 wherein SKORSKI inherently discloses the receiving a request for a specific tangible object, e.g. consumer *selects a link requesting* the online catalog for purchasing a product/object, the consumer *generates an input request* for a particular product, and information about the product will be retrieved, e.g. a user request may be is a retailer or a patient}

f) generating a second view of the same specific tangible object, wherein the second view is generated by applying a second rule associated with the second venue to the same representation of the same specific tangible object read from the same computer readable storage medium such that the second view includes only attributes in compliance with the second rule, and wherein the second view differs from the first view in that at least one attribute included in the second view is not included in the first view; and

{see figures 1-2, at least pars. 0009-0010 wherein SKORSKI discloses different type of user access to see/view different type/attribute of specific product depend of the user's level access into the database system. For example: "a unitary database of product information which will display data (product information) according to selected criteria, and in different formats, according to the type of user that accesses information. In such manner, different populations of users can access different catalogs built from the same data".

see pars. 0017-0019, 0024-0025, 0028-0029, wherein SKORSKI inherently discloses generating a second view of the object applying a second rule, and the second view includes only attributes in compliance with the second rule, not include the first view, and the same specific tangible object read from the same computer readable storage medium. For example, SKORSKI discloses a server is coupled to a database storage computer system which stores data and objects regarding the distributor's products (distributor's database). The database storage computer system may comprise a single database (par 0019); each subset of product group identification generates different price/attributes for the same specific product depends on the different type of user/party. For example: In the distributor's product database, the Price of product X is generated different in the General Catalog than the price of product X in the Dr Jones office catalog as shown on figure 2, par. 0029. If the patient accesses the online medical store to view product information, the information is filtered and only shows the price of specific product as patient level group identification. *The price information of other group (e.g. retailer physicians practice group) will be filtered or the retailer physician's practice will see the same item/product at different price.* This indicates that second view is different than the first view (view different price for the same product) and the information is generated and read from the same computer readable storage medium or the same server/medium is coupled to a database storage computer system.

g) returning the second view to the second venue.

{see at least pars. 0009-0010, 0016, 0023 disclose the display data according selected criteria e.g. selecting the different product group identification}

Note that the general concept of generating a view (or display or web page) of the object based on a rule associated with the first venue (a site) is inherently included in the teachings of SKORSKI as shown on pars. [0009, 0016-0021], and Figs. 2-3.

Alternatively, the teaching of BAMFORD ET AL cited the well known customize information for a product using the pricing rule/engine, e.g. customize the price based on the several factors such as manufacture preferences, distributor preference, identify of a buyer, order volume, the location of buyer. The various manufacturer preferences, distributor preference, or buyer can access the e-market place through the internet, input a request for quote, and then receive a display (view or web page) containing information about a price schedule based on the above factors {see BAMFORD, abstract, see at least figures 1-5, at least col. 3, lines 45-67, col. 4, lines 1-67, col. 5, lines 1-14; col. 5 lines 65-67, col. 6, lines 1-8}.

Therefore, it would have been obvious in one of ordinary skill in the art to modify the teaching of SKORSKI to explicitly include the teaching of selectively displaying requested view (display) as a function of rule associated with the venue (website) as taught by BAMFORD for displaying different customized prices based on the various entities such as on the several factors such as manufacture preferences, distributor preference, identify of a buyer, order volume, the location of buyer.

Note: This appears to be a "data processing" method, therefore, the limitation after "data" or "information" or "attribute" or "view" or "specific tangible object" etc, have

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been determined to be non-functional descriptive material (NFDM), thus having no patentable weight and does not need to be taught by the prior art. Nonfunctional descriptive material can not render nonobvious an invention that would have otherwise been obvious. In re Gulack, 703 F. 2d 1381, 1385, 217 USPQ 401, 40-4 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability. See MPEP 2106.01.

As for dep. claim 20, which discloses the receiving attribute to the specific product or object and storing the attribute in the computer readable storage medium, this inherently included in SKORSKI, see figure 1-3, at least pars. 0019-0020, 0028-0029.

As for dep. claim 21, which describes the specific function of the object or data stored in the database, i.e. an automobile, this is non-functional descriptive material (NFDM) and has no patentable weight. Furthermore, this is inherently taught in SKORSKI as shown in the catalog product database; par. 0003-0005.

As for dep. claim 22, which discloses the venues where websites accessible by users at remote locations, this is taught in SKORSKI figures 1-3, pars. 0018-0019, 0021, 0023.

As for dep. claim 23, SKORSKI discloses different group identification information view different price/attribute for a specific product/object as indicated above. This is inherently included the generating the third view of the specific object by applying the third rule {pars. 0028-0029, figure 2}. Moreover, the duplicate of services

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or steps for multiple effects are well known and would have been obvious to a skilled artisan. See *In re Harza*, 124 USPQ 378, CCPA 1960.

As for dep. claim 24, which discloses the first view includes the first value and excludes the second value, and the second view include the second value excluded the first value, this is inherently taught in *SKORSKI* see figure 2, pars. 0028-0029.

As for independent method claim **25**, which is the combination of independent method claim 19 and 20, it's rejected for the same reason set forth in the rejection of claims 19 and 20 above. Further more, the first limitation which recites "storing a first attribute having first and second values in a database" is non-functional descriptive material which carries no patentable weight.

As for dep. claims 26-30, which basically have the same limitation as in dep. claims 20-24 above, they are rejected for the same reason set forth in the rejection of dependent claims 20-24 above.

As for independent method **claim 32**, which is the combination of independent method claims 19 and further limitations of receiving requests about objects and applying a multiple of rules (second rule or third rule or fourth rule) for each venue. The duplicate of features (tangible objects) or steps (using two rules for each venue) for multiple effects is well known and would have been obvious to a skilled artisan if duplicate effects are desired. See *In re Harza*, 124 USPQ 378, CCPA 1960.

As for dep. claims **33-35**, which deal with basically have the same limitation as in dep. claims 20-22 above, they are rejected for the same reason set forth in the rejection of dependent claims 20-22 above.

As for dep. claim **37**, which deals with applying a multiple of rules (second rule or third rule or fourth rule) for each venue, the duplicate of step or feature (rule) for multiple effects is well known and would have been obvious to a skilled artisan if duplicate rule effects is desired. See *In re Harza*, See *In re Harza*, 124 USPQ 378.

Response to Arguments

9. Applicant's arguments filed on 07/29/09 have been fully considered but they are not persuasive.

As for an argument on pages 12-13 of the remark, Applicant stated that neither SKORSKI nor BAMFORD discloses at least "*generating different views of the same specific tangible object*" and *or/generating the views using data read from the "same computer readable storage medium"* is noted. However this is not persuasive after the Examiner has reviewed the SKORSKI reference. SKORSKI discloses a unitary database of product information which will display data/object according to selected criteria and in different formats, according to the type of user that accesses the information. In such manner, different populations of users can access different catalogs built from the same data (par. 0009); a system define a product range and price and order terms that are unique to each retailer (par. 0016); The Internet web server/Template server is coupled to a database storage computer system which stores data and objects regarding the distributor's product. The database storage computer system may comprise a single database. The data and objects stored in the database storage computer system are filtered through the template server/medium to generate

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custom electronic catalogs upon request from a consumer's computer (par. 0019); A distributor's database which contain the product information, the price for a particular product/item/object will vary, as the patient accessing the online medical store for *patients will view product information and see a displayed retail price, while the retailer physician's practice will see the same item at a different price* (par. 0028). Moreover, SKORSKI figure 2, par. 0029 also discloses how the same product might be presented differently. For example: the Price of product X is generated different in the General Catalog than the price of product X in the Dr Jones office catalog as shown on figure 2, par. 0029. If the patient accesses the online medical store to view product information, the information is filtered and only shows the price of specific product as patient level group identification. *The price information of other group (e.g. retailer physicians practice group) will be filtered or the retailer physician's practice will see the same item/product at different price.* This indicates that second view is different than the first view (view different price for the same product) and the information is generated and read from the same computer readable storage medium or the same server/medium is coupled to a database storage computer system.

As for the reason above, SKORSKI discloses *generating different views of the same specific tangible object" and or/generating the views using data read from the "same computer readable storage medium.*

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thuy-Vi Nguyen whose telephone number is 571-270-1614. The examiner can normally be reached on Monday through Thursday from 8:30 A.M to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on 571-272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/T. N./

Examiner, Art Unit 3689

/Tan Dean D. Nguyen/
Primary Examiner, Art Unit 3689

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